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08/979,810	11/25/1997	TOSHIYUKI ONO	ASA-689	6236

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[REDACTED] EXAMINER

THOMPSON JR, FOREST

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 38

Application Number: 08/979,810

Filing Date: November 25, 1997

Appellant(s): ONO ET AL.

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John R. Mattingly  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 06/03/2003.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

- Whether or not claims 1-14, 29-35, and 37-44 are unpatentable under 35 U.S.C. 103 over Talati et al. (U.S. Patent No. 5,903,878), in view of Weicha (U.S. Patent No. 5,870,717) and Official Notice; and

- Whether or not claim 36 is unpatentable under 35 U.S.C. 103 over Talati et al. (U.S. Patent No. 5,903,878), in view of Weicha (U.S. Patent No. 5,870,717)

**(7) *Grouping of Claims***

The rejection of claims 1-14 and 29-44 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

5,903,878	TALATI et al.	5-1999
5,870,717	WEICHA	2-1999

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-14, 29-35, and 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Talati et al.** (U.S. Patent No. 5,903,878), and further in view of **Wiecha** (U.S. Patent No. 5,870,717) and Official Notice. This rejection is set forth in a prior Office Action, Paper No. 31.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Talati et al.** (U.S. Patent No. 5,903,878), and further in view of **Wiecha** (U.S. Patent No. 5,870,717). This rejection is set forth in a prior Office Action, Paper No. 31.

**(11) Response to Argument**

Please note that examiner rejected claims 1-14, 29-35, and 37-44 as being unpatentable over **Talati et al.** (U.S. Patent No. 5,903,878), and further in view of **Wiecha** (U.S. Patent No. 5,870,717) and Official Notice. Appellants did not traverse the examiner's taking of Official Notice in the prior office action rejection (see Paper #31). Therefore, examiner takes the well-known in the art statement to be admitted prior art.

**Appellants argue**, at 5-6 and 16-17, that the Examiner relies upon **Talati** for disclosing the receiving of a present status of processing for delivery of a product corresponding to an order, however, **Talati** merely discloses the delivery of e-mail in an e-mail delivery system 305 shown in Fig. 11. Specifically, the Examiner relies upon col. 8, lines 62-67 of the reference for disclosing an e-mail record 330 and unique transaction identifier (UTID) 331. However, this disclosure does not suggest to one having ordinary skill in the art of providing a client with present status of processing of trading as in the present invention.

**Examiner disagrees.** Additionally, **Talati et al.** discloses:

- (col. 1 lines 56-67) *The delivery system between the client 10 and the merchant 20 can be a regular mail system, telephone system, computer network or any other delivery system like UPS or Federal Express. The delivery system between the client*

*10 and the merchant 20 must also have some tracking capability. The delivery system between the merchant 20 and the CCA 30 is typically a private network providing Point-Of-Sale (POS) processing. All necessary information is transferred between two or more points in this network with a tracking mechanism that can follow the transactions.*

*All of the above steps can also be executed within electronic commerce transactions.*

- (col. 3 lines 50-60) *Upon receipt of the validation request, the client decodes, if necessary, the encrypted validation request and extracts the unique transaction identifier therefrom. The identifier is compared to a listing of generated transaction identifiers at the client to confirm that the client authorized the transaction order with which the transaction identifier is associated. Confirmation or denial of the validation is transmitted back to the TA by the originator. This confirmation may be encrypted using a suitable encryption method, if necessary. To provide additional security, a query or group of queries may be included within the validation requests between the TA and the originator. These queries are randomly generated and directed to information known solely by the originator, such as mother's maiden name, social security number, driver's license number, birth date, etc.*

- (col. 5 lines 27-32) *Upon receipt of the transaction validation from the originator 50, the transaction administrator 60 validates the originator 50 and the transaction request at step 120, and notifies the recipient 55. The originator 50 and recipient 55 then complete the transaction at step 125.*

- (col. 8 lines 17-61) *The communications between the originator 50 and TA 60 or between the recipient 55 and the TA 60 can be established with any traceable delivery*

*system, such as a point-to-point tunneling protocol (PPTP) which is equivalent to a telephone virtual circuit. However, an e-mail system also provides a traceable delivery system in an alternative embodiment an e-mail delivery system may be used not only to exchange information, but to process complex transactions and safely share information between multiple entities. Referring now to FIG. 11, there is illustrated an e-mail control system (ECS) 300 enabling electronic commerce transactions on the Internet between an originator 50, recipient 55, and transaction administrator 60. The system guarantees the validity of the electronic commerce transaction by validating that the client owning a presented credit card number, unique transaction identifier, transaction amount, etc., has initiated the transaction. There exists a traceable delivery system on computer networks such as the Internet, Intranet or private network, namely e-mail. An existing e-mail system may be extended so that an originator 50 can openly use payment numbers, such as credit card numbers and account numbers, over the Internet. The terms E-mail and e-mail are synonymous. In this example an ECS 300 interfaces with an e-mail delivery system 305 using the SMTP protocol to send mail and the POP3 protocol to receive mail. The ECS 300 enforces the new behavior of the e-mail delivery system 305 to perform transactions between the originator 50, the recipient 55 and the transaction administrator 60. The ECS 300 may be implemented in single or multiple processors wherein separate processors control transaction e-mails and normal e-mails . . . The ECS 300 uses the e-mail delivery system 305 (or suitable applications or functions) in conjunction with a mailbox database 315 to create, reply to or view e-mail messages. The ECS 300 sends and receives e-mail messages to/from the e-mail*

*delivery system 305 using send mail 310 and receive mail 320 actions/functions of the e-mail system. The ECS 300 includes information such as UTID, OID and transaction data within a transaction e-mail and enables extraction of this information at a receiving part for further transaction processing such as validation. The mailbox database 315 includes a plurality of e-mail records 330, each having a unique transaction identifier 331 (FIG. 12) associated therewith that has been generated by the e-mail control system 300.*

Thus, Talati discloses using an e-mail to deliver orders, process transactions, exchange information, and provide status information that encompasses Appellants' inventive step of providing a client with present status of processing of trading as in the present invention.

Therefore, examiner maintains the rejection.

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**Appellants argue**, at 5-7, that Talati is directed to communications concerning transactions that are handled by an e-mail delivery system. The "delivery" that is described by Talati is not the delivery of a product corresponding to an order, as in the present invention, but rather the delivery of e-mail as part of the communication between the originator 50 and TA 60.

**Examiner disagrees.** Talati discloses *The delivery system between the client 10 and the merchant 20 can be a regular mail system, telephone system, computer network or any other delivery system like UPS or Federal Express. The delivery system*

*between the client 10 and the merchant 20 must also have some tracking capability.*

*The delivery system between the merchant 20 and the CCA 30 is typically a private network providing Point-Of-Sale (POS) processing. All necessary information is transferred between two or more points in this network with a tracking mechanism that can follow the transactions. All of the above steps can also be executed within electronic commerce transactions.* (col. 1 lines 56-67) Examiner maintains that this disclosure encompasses the delivery of a product corresponding to an order, to include additional communications considered necessary by the client, the carrier, and/or the merchant.

Therefore, examiner maintains the rejection.

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**Appellants argue**, at 8-9, that the rejection does not set forth the prior art being relied upon for suggesting that it would be obvious to receive trading processing information that includes present status of processing for delivery of a product as claimed by Applicants . . . Wiecha does not disclose the status of the delivery of the product as in the present invention, which is received from the communication network through which the order for the product is transmitted.

**Examiner disagrees.** Talati discloses (at col. 5 lines 15-32) a present status of the order when the originator is required to validate the order (or not) for the transaction to be completed. Weicha discloses (at col. 9 lines 60-63 and col. 10 lines 38-44) status updates from the vendors that are provided and provided to a purchaser. The feature of

*the present status of processing for delivery of a product* is encompassed by the combination of the Talati et al. and Weicha disclosures.

Therefore, examiner maintains the rejection.

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**Appellants argue**, at 9-11, that, although the Examiner recognizes the need to provide a proper motivation for suggesting the modification to Talati required in the rejection, the motivation provided by the Examiner to arrive at the claimed invention from the references is based on the proposed modification attaining "the functionality that users desire in reviewing and managing their requested processing (i.e. purchases)." See, page 35, lines 3-4 of the final Office Action. This is not proper motivation to combine, however, because the teachings of the present invention concerning the way in which users are enabled to use the method and system of the present invention are relied upon as the justification for combining the references . . . Wiecha does not overcome the deficiencies of the Talati reference. In particular, Wiecha is directed to an electronic commerce ordering system wherein trading processing information is added to trading information to make a contract for the trade, as described at col. 4, lines 1-30 of the reference, for example.

**Examiner disagrees.** Examiner did use as a motivation the phrase "*the functionality that users desire in reviewing and managing their requested processing (i.e. purchases).*" Examiner asserts that users of purchasing systems DO (emphasis added) desire to be informed of the status of their orders and to have some capability to review, change, edit, or otherwise monitor their orders in some circumstances.

However, examiner also asserts that the two references are of related prior art by at least the fact the both are classed in the 705/26 patent art (i.e., the same as Appellants' application), and both references disclose inventions for conducting electronic commerce that, in combination, encompass Appellants' invention.

Therefore, examiner maintains the rejection.

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**Appellants argue**, at pg. 11-12, that, as an additional step, the trading identifier is compared with the e-mail address included in the trading information and a warning is output if they are not coincident. If they are coincident, then the trading processing information is added to the trading information stored in a storage device. This aspect of the claimed combination of claim 1 is not suggested by the Talati reference in view of Wiecha.

**Examiner disagrees.** Talati et al. discloses an e-mail message from an originator of an order that contains the originator's e-mail address, the OID, UTID and document name (col. 11 line 38 – col. 12 line 8). Also, in this disclosure, Talati et al. specifically discloses *The originator 50 validates transactions by comparing UTID with a list 100, including UTIDs generated by the originator along with associated information. The originator 50 sends a negative acknowledgment due to failure to match a UTID or associated information if the transaction is invalid or a positive acknowledgment if the transaction is valid and the UTID and associated information matches at 445. The TA 60 upon receipt of a positive or negative validation of the transaction with the associated*

*UTID notifies the recipient of a positive status at 450.* Examiner asserts that this disclosure encompasses Appellants' claimed aspect.

Therefore, examiner maintains the rejection.

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**Appellants argue**, at pg. 12, that each of the pending claims is directed to transmitting trading processing information to the client which includes the present status of processing for processing initiated for an order. This aspect of the claimed combination is also not set forth in the Talati and Wiecha references.

**Examiner disagrees.** Talati discloses (at col. 5 lines 15-32) a present status of the order when the originator is required to validate the order (or not) for the transaction to be completed. Wiecha discloses (at col. 9 lines 60-63 and col. 10 lines 38-44) status updates from the vendors that are provided and provided to a purchaser. The feature of *the present status of processing for processing* is encompassed by the combination of the Talati et al. and Wiecha disclosures. Therefore, examiner maintains the rejection.

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**Appellants argue**, at pg. 13-14, that, as noted by the Examiner, Appellants take the position that claim 1, for example, is not suggested by the Talati et al reference in view of Wiecha. In response, the Examiner notes that Wiecha discloses that a purchaser can update the status of a PO manually after receiving acknowledgements, status updates, etc. from vendors via fax, phone or mail. However, according to the invention as claimed the status of the delivery of the product in the present invention is

received from the communication network through which the order for the product is transmitted, which is different from Wiecha.

**Examiner disagrees.** As stated in the above examiner responses, claim 1 is encompassed by the combination of Talati et al. and Weicha, as stated in examiner responses above. Also, Weicha discloses the use of a computer network for a customer to originate and transmit an order (Abstract). Examiner submits that this disclosure encompasses the claimed aspect. Therefore, examiner maintains the rejection.

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**Appellant argues,** at pg. 15-16, that, although the Examiner notes that Talati discloses a present status of processing for processing initiated for an order, referring to col. 11, lines 38-67 and col. 12, lines 1-19 of the reference, the processing referred to is not initiated for information items such as DELIVERED/NOT DELIVERED 1201 or DELIVERY SCHEDULE/DELIVERED DATE 1202 shown in Fig. 12 of the present application . . . Thus, the present status of processing claimed by Appellants is different from that disclosed by Talati et al.

**Examiner disagrees.** Examiner notes that, as presented by examiner in the above responses to arguments, Talati et al. (in combination with Weicha) discloses the claimed aspects of Appellants' invention. Specifically, Talati et al. (in combination with Weicha) discloses the present status of processing, as claimed by Appellants. The specific terms of DELIVERED/NOT DELIVERED 1201 or DELIVERY

SCHEDULE/DELIVERED DATE 1202, as argued by Appellants, are not in Appellants' claimed aspects, but are within the functional bounds of the identified prior art.

Therefore, examiner maintains the rejection.

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**Appellant argues**, at pg. 17-18, that the references when taken together do not suggest the status of the delivery of the product and payment of the product through a communication network as claimed by Appellants.

**Examiner disagrees.** Talati discloses (at col. 11 lines 27-37): *Each of the e-mail messages transmitted by the e-mail delivery system 305 are responsive to queries to the e-mail control system 300 generated by a transaction request. The transaction request causes the e-mail control system 300 to generate the e-mail record 330 having the unique global transaction identifier or message identifier 331, a mail type identification 335 indicating a transaction, and the mail content 348, including all information necessary to perform the validation and authorization procedures at the credit authorities or transaction administrator and the transaction originating party.*

Talati et al. also discloses information exchanges between the client (purchaser), the merchant, the credit authorities and/or transaction administrator. The Examiner asserts that this disclosure encompasses the features of the status of delivery and payment of the product through a communications network as claimed by Appellants.

Therefore, examiner maintains the rejection.

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**Appellant argues**, at pg. 17-18, that neither of the references discloses or suggests that part of the combination which sets forth the comparing of a trading identifier and e-mail address included in the trading information with the trading identifier included in the trading processing information to output a warning if they are not coincident, and further to add the trading processing information to the trading information stored in the client's storage device if they are coincident.

**Examiner disagrees.** Talati et al. discloses an e-mail message from an originator of an order that contains the originator's e-mail address, the OID, UTID and document name (col. 11 line 38 – col. 12 line 8). Also, in this disclosure, Talati et al. specifically discloses *The originator 50 validates transactions by comparing UTID with a list 100, including UTIDs generated by the originator along with associated information. The originator 50 sends a negative acknowledgment due to failure to match a UTID or associated information if the transaction is invalid or a positive acknowledgment if the transaction is valid and the UTID and associated information matches at 445. The TA 60 upon receipt of a positive or negative validation of the transaction with the associated UTID notifies the recipient of a positive status at 450.* Examiner asserts that this disclosure encompasses Appellants' claimed aspect.

Therefore, examiner maintains the rejection.

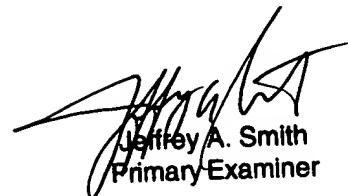
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Jeffrey A. Smith  
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